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| 09/879,683 | 06/11/2001 | Limor Schweitzer | XACTP006 | 4994 |

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| EXAMINER |
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MILEF, ELDA G

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| ART UNIT | PAPER NUMBER |
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3692

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 12/28/2006 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/879,683 | Applicant(s) SCHWEITZER, LIMOR | |
| | Examiner Elda Milef | Art Unit 3692 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/21/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/6/2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-7 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is confusing. Further explanation is required as to who is specifically doing the steps involved. Claim 5 is

depending from claim 2 which states " a site sends the information...", claim 5 then recites "and sending the user data to the site." Clarification is required.

Claims 6-7 and 18-19 are rejected because of their dependency to the rejected claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,4,5,8,11,13,14,16,17,20,23,25,27,28 are rejected under 35 U.S.C. 102(b) as being anticipated by Ronen et al. (hereinafter Ronen, US Patent No. 5,905,736).

Re claims 1, 13, 25: Ronen disclose a method, computer program product, and system comprising:

receiving information utilizing a network, wherein the information includes an Internet Protocol (IP) address of a user and an amount of payment due ("the ISP transmits to the billing platform the IP address identity of the user making the

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transaction and the cost associated with the transaction")-see col. 2 lines 13-16;

identifying an account using at least a portion of the IP address; and administering payment for the payment due by billing against the account. ("The billing server then cross-references the IP address associated with the cost...with the IP address/transaction received from the ISP to properly charge an established account of the user for the transaction...")-see col. 2 lines 16-30, cols. 3-4.

Re claim 2, 14: Ronen disclose wherein a site sends the information in response to the user carrying out a transaction using the site ("In response to a chargeable transaction with an ISP, the ISP transmits to the billing platform the IP address of the user making the transaction and the charge for the transaction")-see Abstract, col. 2 lines 5-30.

Re claim 4,16: Ronen disclose wherein the steps are carried out by a network service provider.-see cols. 2-4, Fig. 1.

Re claim 5,17: For purposes of examination, the Examiner is interpreting claim 5 to mean identifying user data based on the received information and transmitting the user data to the billing platform.-see col. 2, Abstract, and Fig. 1.

Re claims 8, 11, 20,23: Ronen disclose limiting the administration of payment based on a rule and wherein the

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account is a debit account-see col. 7 lines 37-40, Fig. 1 (120-3).

Re claim 27: Ronen disclose wherein the information is received from a combination of the user and a site, where the information is received from the site in response to the user carrying out a transaction using the site.-see col. 2.

Re claim 28: Ronen disclose wherein the account is identified utilizing a database which links the information with a corresponding account. -see col. 2 lines 16-30, cols. 3-4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 3,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen in view of Stewart (Stewart, John. *Connecting with Confidence*. Web Techniques. San Francisco: Apr 2000. Vol. 5, Iss. 4; pg. 84, 4 pgs.

Re claim 3: Although Ronen refers to identifying information relating to a customer such as an internet address - see col. 2, Ronen does not specifically disclose wherein the information further includes port numbers. It is well known in the art as evidenced by Stewart, that port numbers are a way to identify a specific process to which an internet message is to be forwarded when it arrives at a server. ("The rules are simple: Control which machines (using IP addresses) can talk to one another on what services [using network port numbers].")-see p. 3, para. 2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include identifying a transaction by using a port number, as was taught by Stewart in order to control the transfer of information over the Internet.

Re claim 15: Further a computer program would have been necessary to perform the method of previously rejected claim 3 and is therefore rejected using the same art and rationale.

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5. Claims 7, 12, 19, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen in view of Wilf et al. (hereinafter Wilf, U.S. Patent No. 5,899,980).

Re claim 7: Ronen do not specifically disclose requesting permission from the user prior to sending the user data to the site. Wilf however, teaches that the customer can either confirm or deny the transaction after inspecting the transaction details. -see col. 8 lines 12-41, col. 9 lines 18-20, col.3. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include enabling the customer to confirm the transaction as taught by Wilf in order to provide the customer with details including the price and payment terms before the customer agrees to the transaction and before transaction details are forwarded to the point of sale computer station or to the ISP.

Re claim 12: Ronen do not specifically disclose wherein the steps are carried out by a financial institution offering credit with credit cards in conjunction with a network service provider. Wilf however, teaches ("The STSP, the customers, the vendors and the ISPs receive financial services from one or more financial service providers...")-see col. 7 in particular, lines 26-33. It would have been obvious to one having ordinary skill

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in the art at the time the invention was made to modify Ronen to include a financial service provider offering services as taught by Wilf in order to provide the customer with convenient payment options.

Re claims 19, 24: Further a computer program product would have been necessary to perform the method of previously rejected claims 7, 12 and are therefore rejected using the same art and rationale.

6. Claims 6,9,10,18,21,22,26,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen in view of Egendorf (U.S. Patent No. 5,794,221) in further view of official notice.

Re claim 6,18: Ronen disclose the purchasing of goods that will later be delivered by conventional transport means-see col. 1 lines 1-19. Ronen do not specifically disclose wherein the user data includes shipping information. Egendorf teaches shipping information-see col. 4, lines 1-6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to specifically include that user data includes shipping information as taught by Egendorf in order for the vendor to ship products to the correct user destination.

Re claims 9 and 10: Ronen do not specifically disclose collecting a fee from the site and the fee is a percentage of the payment due. Egendorf however, teaches ("The provider then bills the transaction amount to the customer and remits a portion of the transaction amount to the vendor, keeping the differential as a fee for providing the service")-see Abstract, and col. 4, lines 18-22. Official notice is taken that it is old and well known in the art of e-commerce that a fee is a percentage of payment due. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include charging a fee as a percentage of payment due as taught by Egendorf and is old and well known, in order for the provider to generate income from the services provided to the vendor and consumer.

Re claims 21, 22: Further a computer program product would have been necessary to perform the method of previously rejected claims 9 and 10 and are therefore rejected using the same art and rationale.

Re claim 26: Ronen disclose: (a) providing a link to a site on a network where a business transaction is occurring; and (b) receiving information from the site at a third party location during the transaction wherein the information includes an

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Internet Protocol (IP) address of a user and an amount of payment due -see cols 1-2. The remaining steps have similar limitations found in claims 1, 6, 8, 9 above, and therefore are rejected by the same art and rationale.

Re claim 29: Ronen do not specifically disclose:

wherein the user gives permission (agreement) for the payment to be administered. Egendorf however teaches user permission in col.4 line 67-col. 5 line 10, col. 6 lines 13-35, and in response to the user giving the permission, providing the site with a confirmation a number and a shipping address of the user and providing the user with the confirmation number. Egendorf however teaches customer authorization, verification of address, providing a reference number or verifying information to the customer.-see cols.3-5. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include a customer authorizing a transaction, the vendor subsequently verifying with the provider that the address supplied by the customer has been authorized by the customer, and providing a reference number to the customer as taught by Egendorf in order to protect the buyer and seller from fraudulent transactions.

Ronen and Egendorf do not explicitly disclose providing a uniform resource locator (URL) link to the user from a site

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which gives permission for the payment to be administered. Official notice is taken that it is old and well known in the art of Internet e-commerce that a URL is an address for a resource on the Internet. A URL specifies the protocol to be used in accessing the resource and as such is used to access a web page, a server, a path to a resource such as an HTML document or a file on that server. It would have been obvious to one having ordinary skill in the art to modify Ronen and Egendorf to explicitly disclose a URL link in order to access a server that has payment instruction as is old and well known in order to provide the user with a quick method of payment.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Franklin et al. (U.S. Patent No. 6,125,352)-cited for a system and method for conducting commerce over a distributed network.

Rose et al. (U.S. Patent No. 5,757,917)-cited for a computerized payment system for purchasing goods and services on the Internet including service charges, user-buyer confirmation, authorization code, shipping information, buyer authorization.

McDonald, Glenn. *Sold! How to Win at Web Auctions*. PC World Online. San Francisco: Aug. 5, 1999. pg.1.-cited for its reference to escrow services charging fees which are a percentage of a purchase price.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday -Thursday 8:30 am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elda Milef
Examiner
Art Unit 3692

**RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER**

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